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REMARKS

Applicant hereby renews the Petition for suspension of the requirement of 37 C.F.R. §1.131, which states that all joint inventors must participate in a Declaration establishing invention of the claimed subject matter prior to the effective date of a cited reference. Applicant also hereby renews the Petition for suspension of the requirement of 37 C.F.R. 1.48 that all joint inventors must participate in a Declaration to correct inventorship. Specifically, joint inventors Winnie Durbin, Karamjeet "KJ" Singh, and Kun Zhang are no longer employed by the Assignee of the present application and Applicant has provided evidence that they are each unavailable or unwilling to cooperate.

In view of the Decision on Petition mailed November 6, 2008 ("the Decision"), Applicant believes it's previous Renewed Petition under 37 C.F.R. 1.183, dated October 2, 2008, was improperly dismissed. Applicant notes that the October 2, 2008 Petition was a Renewed Petition filed in view of a Petition under 37 C.F.R. 1.183, filed May 12, 2008, which was dismissed in an August 5, 2008 Decision on Petition. While the current Decision accepted that Applicant had shown that Inventor Zhang was unreachable, the reason given for dismissal of the October 2, 2008 Renewed Petition was that "[p]etitioners have not established that Inventors Singh and Durbin cannot be located." *Decision*, November 6, 2008, p. 2.

First, Applicant notes that Inventor Singh was already found to have been unwilling to cooperate with signing the Declaration under 37 C.F.R. §1.131 in a granted Petition Decision dated October 12, 2007. Accordingly, Applicant believes that the previous finding by the PTO that Inventor Singh is unavailable is controlling and is sufficient to suspend the rules in view of 37 C.F.R. § 1.183.

Secondly, Applicant relied upon the Petition Attorney's own suggestions provided in the August 5, 2008 Decision on Petition in order to further establish that Inventors Singh and Durbin are either unreachable or unwilling to cooperate. Specifically, the Petitions Attorney recommended the following:

"In short, Inventors Singh and Durbin should be mailed a copy of the application, along with a copy of the May 12, 2008 declaration for patent application and a copy of the May 12, 2008 Rule 131 declaration for their execution. When petitioners can show that Inventors Singh and Durbin were successfully mailed or received the aforementioned documents and that they either refused to sign the declarations within a reasonable amount of time, petitioners will have satisfied this requirement."

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Decision, August 5, 2008, p. 4. Accordingly, Applicant mailed a letter, along with the Declaration of Inventorship and the Rule 1.131 Declaration, via certified mail to the last known address of both Inventor Singh and Inventor Durbin on August 20, 2008. The letter to Inventor Singh was returned as undeliverable by the U.S. Postal Service on August 27, 2008, while the letter to Inventor Durbin was returned as undeliverable on August 26, 2008. Copies of these documents were submitted as Exhibits A-D in the October 2, 2008 Petition. Applicant clearly complied with the Petitions Attorney's instructions regarding the mailing of the letter and Declaration to the last known addresses of Inventors Singh and Durbin.

However, despite Applicant's diligence in seeking the signatures of Inventors Singh and Durbin, the Petitions Attorney directly contradicted the previous suggestions and stated that "[o]ne returned mailing does not meet the required level of diligence that must be shown in order to obtain waiver of signature requirements." *Decision*, November 6, 2008, p. 2. It is noted that the last Petition is not to be reviewed in a vacuum as it was a '*renewed*' Petition that is *renewing* Applicant's previously submitted Petition. It is not a new Petition. The Examining Attorney should be considering the evidence submitted originally as well as the *Renewed* Petition evidence.

Clearly, Applicant's submissions to Inventors Singh and Durbin were compliant with the Petitions Attorney's suggestions, and together with the original Petition, should have been considered sufficient to show that Inventors Singh and Durbin were unreachable. Applicant requests that the Petitions Attorney consider all submissions showing that Inventors Singh and Durbin were either unwilling to cooperate or unreachable, particularly in view of the Petitions Attorney's own suggestions. Applicant respectfully requests reconsideration of the October 2, 2008 *Renewed* Petition based on the original Petition and the fact that one of the aforementioned inventors has already been found to be unavailable by the PTO.

Additionally, the listing of "evidentiary sources" that may be relied upon to prove Applicant's inability to locate the inventors or show that they refused to sign has also been inconsistent between the various Petition Decisions from the Office. That is, in the August 5, 2008 *Decision*, the Petitions Attorney set forth that "emailing is generally not accepted as a means to communicate with non-signing inventors." *Decision*, August 5, 2008, p. 3 (emphasis added). However, in the most recent *Decision* mailed November 6, 2008, the same Petitions Attorney stated that "[t]he following is a list of evidentiary sources that are commonly relied upon to prove inability to locate the inventor: searches of Internet databases; inquiries of local telephone directories; inquiries of former co-workers; E-mail; etc." *Decision*, November 6, 2008, p. 2. Applicant had previously relied upon e-mail inquiries and inquiries of former co-workers

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(and a spouse) to show that Inventor Durbin refused to cooperate with signing the Declaration under 37 C.F.R. § 1.131 in the Petition filed May 12, 2008, but was instructed that such inquiries were insufficient and that an inquiry via mail was recommended. Further, email inquiries were made to Inventor Singh, as shown in the June 12, 2007 Renewed Petition under 37 CFR 1.183, along with an inquiry via postal mail on August 20, 2008. Now, however, Applicant has been informed that postal inquiries are also not sufficient. Having made inquiries both via e-mail and via postal mail so as to contact both Inventors Singh and Durbin, surely Applicant has made a diligent effort to locate the inventors. While these inquiries may not have been submitted as evidence in one single Petition under 37 CFR 1.183, Applicant requests that the Office consider the evidence submitted in each of the Petitions under 37 CFR 1.183 (e.g. the original Petition and the *Renewed* Petition), as the cumulative evidence clearly shows diligence on the part of Applicant in attempting to contact the inventors.

In summary, Applicant believes that the evidence submitted in support of the Petitions under 1.183 for the instant application are, as a whole, sufficient to grant the Petition under 37 C.F.R. § 1.183 for suspension of the requirements of 37 C.F.R. § 1.131 and 37 C.F.R. § 1.48 regarding inventor signatures. This evidence includes:

- An email from Inventor Singh stating that he did not wish to cooperate with signing the required documents (*See Renewed Petition under 1.183*, June 12, 2007, Exh. F).
- An undeliverable email to Inventor Durbin sent to her last known email address (*See Renewed Petition under 1.183*, May 12, 2008, Exh. A).
- An email inquiry to Inventor Durbin's spouse (and co-worker), wherein Inventor Durbin's spouse indicated that she did not wish to be contacted (*See Renewed Petition under 1.183*, May 12, 2008, Exh. A).
- A certified mail return receipt confirming that the letter and documents sent to Inventor Singh's last known address were returned as undeliverable (*See Renewed Petition under 1.183*, October 2, 2008, Exh. A-B).
- A certified mail return receipt confirming that the letter and documents sent to Inventor Durbin's last known address were returned to sender (*See Renewed Petition under 1.183*, October 2, 2008, Exh. C-D).

In view of the evidence above, along with the remarks set forth in the multiple Petitions under 37 CFR 1.183 submitted with respect to this application, Applicant believes that a diligent effort was indeed made to contact the non-signing inventors. Accordingly, Applicant respectfully

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requests that the Office grant the Petition under 37 C.F.R. § 1.183 for suspension of the rules of §1.131 and § 1.48 requiring signatures from all joint inventors on the Declarations.

Applicant appreciates the consideration of this Petition and invites the Office of Petitions to contact the undersigned, should any matters be considered unresolved.

Respectfully submitted,

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